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**KEATING & BENNETT LLP**

# Fax

**To:** Examiner A. Kinhead**From:** Christopher A. Bennett**Fax:** 703-872-9319**Date:** July 25, 2003**Phone:** 703-305-3486**Pages:** 12**Re:** 09/731,004**CC:**

36856.885

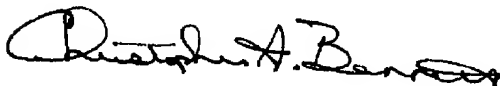
**•Comments:**

Examiner Kinhead,

Please find attached the following documents U.S. Application No. 09/731,004:

1. Amendment After Final Rejection;
2. Petition for 3-months extension of time;
3. Credit card form payment in the amount of \$930.00;
4. Notice of Appeal (2 copies); and
5. Credit card form payment in the amount of \$320.00.

Respectfully submitted,



Christopher A. Bennett  
for  
KEATING & BENNETT, LLP  
(Reg. No. 46,710)

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**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this correspondence is being transmitted to  
Group Art Unit 2817, 703-872-9319, addressed to:  
Commissioner for Patents, P.O. Box 1450, Alexandria, VA  
22313-1450.

Date: July 25, 2003

Sonia V. McVean  
Sonia V. McVean

**RESPONSE UNDER 37 C.F.R. § 1.116  
EXPEDITED PROCEDURE  
GROUP ART UNIT 2817**

**PATENT  
36856.885**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Fumitoshi SATO	Art Unit: 2817
Serial No.: 09/731,004	Examiner: A. Kinkad
Filed: December 6, 2000	
Title: OSCILLATOR	

**REQUEST FOR RECONSIDERATION****FAX RECEIVED**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

JUL 25 2003

TECHNOLOGY CENTER 2800

Sir:

In response to the Office Action dated February 12, 2003, the period for response to which has been extended to August 12, 2003, by the accompanying Petition for a THREE-month Extension of Time, please reconsider the above identified application in view of the following remarks.

Claims 1-14 are pending in this application.

The Examiner has indicated that the outstanding Office Action is a Final Office Action (paragraph no. 2 on page 5 of the Office Action). The Examiner is reminded "[b]efore [a] final rejection is in order[,] a clear issue should be developed between the examiner and applicant." MPEP § 706.07 (emphasis added).

First, Applicant requested in the Request for Reconsideration dated November 21, 2002 that the Examiner provide a reference or a personal affidavit to support his allegation that it was well known at the time of Applicant's invention to have an element in an oscillator for decreasing the power amplification of an "amplifying circuit by at least 3 dB in a frequency band lower than about 0.5 times an oscillating frequency  $f_0$  or

Serial No. 09/731,004

July 25, 2003

Reply to the Office Action dated February 12, 2003

Page 2 of 6

higher than about  $2f_0$ ." The Examiner has failed to make any mention of this request and has failed to provide a reference or personal affidavit in support of his allegation.

Second, the Examiner has completely ignored Applicant's argument that the Examiner has used an inappropriate standard of patentability. In fact, as noted below, the Examiner has insisted upon using the inappropriate standard by repeating this "well within the skill" standard in the *Response to Arguments* section on page 4 of the Office Action.

Third, the Examiner has completely ignored the request in the Request for Reconsideration dated November 21, 2002 that the Examiner respond to the request in the Amendment dated March 4, 2002 to provide references or a personal affidavit as required by MPEP § 707.07(f) and 37 CFR 1.104.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the Finality of the outstanding Office Action in order for the Examiner, to at least, a) provide a reference or a personal affidavit to support his allegations of unpatentability; and b) apply the appropriate standards of patentability to Applicant's claimed invention.

Claims 1-8 and 12-14 were rejected under 35 USC § 103(a) as being unpatentable over Lewis (U.S. Patent No. 5,748,051) in view of Razavi (RF Microelectronics, 1998). Claims 1-14 were rejected under 35 USC § 103(a) as being unpatentable over Van Amesfoort (U.S. Patent No. 5,712,596) in view of Razavi.

Applicant respectfully traverses the rejections of claims 1-14.

Claims 1, 4, and 6 recite in part:

**"wherein said amplifying circuit comprises an element having a frequency characteristic, thereby decreasing power amplification of said amplifying circuit by at least 3 dB in a frequency band lower than about 0.5 times an oscillating frequency  $f_0$  or higher than about  $2f_0$ , as compared to the power amplification of said amplifying circuit at the oscillating frequency  $f_0$ ." (emphasis added)**

The Examiner has stated in paragraph no. 1 on page 4 of the Office Action that "[t]he examiner has considered applicant's concern that the reference by Razavi does

Serial No. 09/731,004

July 25, 2003

Reply to the Office Action dated February 12, 2003

Page 3 of 6

not suggest the asymmetrical bandpass transfer function with the 3dB bandwidth, however, the examiner was relying on this [Razavi] to show in general how the resonant circuits of the other references have a 2 sided 3dB bandwidth to define the Q of the resonator tank and thus it would have well within the skill in the art to define the particular bandpass of characteristics, symmetrical or other wise" (emphasis in original).

First, the Examiner has admitted that **NONE** of the prior art of record teaches or suggests asymmetrical bandpass transfer functions. And by inference, the Examiner has admitted that **NONE** of prior art of record teaches or suggests "an element having a frequency characteristic, thereby decreasing power amplification of said amplifying circuit by at least 3 dB in a frequency band lower than about 0.5 times an oscillating frequency  $f_0$  or higher than about  $2f_0$ , as compared to the power amplification of said amplifying circuit at the oscillating frequency  $f_0$ " as recited in Applicant's claims 1, 4, and 6.

It is a fundamental principle of U.S. patent law that "the prior art reference (or references when combined) must teach or suggest all the claim limitations" (emphasis added). MPEP § 706.02(j). As in the Request for Reconsideration dated November 21, 2002, the Examiner is hereby requested to cite a reference in support of his position that it was well known at the time of Applicant's invention to use "an element having a frequency characteristic, thereby decreasing power amplification of said amplifying circuit by at least 3 dB in a frequency band lower than about 0.5 times an oscillating frequency  $f_0$  or higher than about  $2f_0$ , as compared to the power amplification of said amplifying circuit at the oscillating frequency  $f_0$ " as recited in Applicant's claims 1, 4, and 6. If the rejection is based on facts within the personal knowledge of the Examiner, the data should be supported as specifically as possible and the rejection must be supported by an affidavit from the Examiner, which would be subject to contradiction or explanation by affidavit of Applicant or other persons. See 37 C.F.R. § 1.104(d)(2).

Second, Applicant is completely bewildered by the Examiner's insistence on

Serial No. 09/731,004  
July 25, 2003  
Reply to the Office Action dated February 12, 2003  
Page 4 of 6

repeating the conclusion that "it would have been well within the skill for one of ordinary skill in the art to define the particular bandpass of characteristics, symmetrical or otherwise" in the *Response to Arguments* section including paragraph no. 1 on page 4 of the Office Action. **As argued in the Request for Reconsideration dated November 21, 2002,** the "well within the skill" standard of patentability used previously and currently in both of the prior art rejections is an **INAPPROPRIATE** standard of patentability.

More importantly, **as argued in the Request for Reconsideration dated November 21, 2002,** the Examiner's conclusion is based upon a standard of patentability that is **NOT SUPPORTED BY STATUTE, COURT DECISION, OR THE MPEP**. In fact, MPEP § 2143.01 states:

A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.). (emphasis in original)

Thus, Applicant respectfully requests that the Examiner apply the appropriate standards of patentability to Applicant's claimed invention.

**As noted in the Request for Reconsideration dated November 21, 2002,** Applicant's invention must be considered "as a whole". **Medtronic, Inc., v. Cardiac Pacemakers, Inc.**, 721 F.2d 1563, 220 USPQ 97, 99-100 (Fed. Cir. 1983). Rather than considering the invention "as a whole," the Examiner improperly reduced Applicant's

Serial No. 09/731,004

July 25, 2003

Reply to the Office Action dated February 12, 2003

Page 5 of 6

claimed invention to the "idea" of using a 3 dB bandwidth design. Reducing a claimed invention to an "idea" and then determining patentability of that "idea" is error. Jones v. Hardy, 727 F.2d 1524, 1528, 220 USPQ 1021, 1024 (Fed. Cir. 1984).

Furthermore, the Examiner has completely failed to explain how the LC tank of Razavi, which inherently has a symmetrical bandpass transfer function as is clearly shown in Fig. 7.17, could or should be modified such that it has an asymmetrical bandpass transfer function. The Examiner has only alleged that the LC tank can be so modified without offering any evidence of how this could be done.

In addition, there is absolutely no teaching or suggestion whatsoever in Razavi or any prior art of record of: (1) an asymmetrical bandpass; (2) how or why Razavi could or should be modified to have an asymmetrical bandpass; (3) an element having a frequency characteristic, thereby decreasing power amplification of said amplifying circuit by at least 3 dB in a frequency band lower than about 0.5 times an oscillating frequency  $f_0$  or higher than about  $2f_0$ , as compared to the power amplification of said amplifying circuit at the oscillating frequency  $f_0$ ; and (4) how or why Razavi could or should be modified to have an element having a frequency characteristic, thereby decreasing power amplification of said amplifying circuit by at least 3 dB in a frequency band lower than about 0.5 times an oscillating frequency  $f_0$  or higher than about  $2f_0$ , as compared to the power amplification of said amplifying circuit at the oscillating frequency  $f_0$ .

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1, 4, and 6 under 35 USC § 103(a) as being unpatentable over Lewis in view of Razavi and under 35 USC § 103(a) as being unpatentable over Van Amesfoort in view of Razavi.

Accordingly, Applicant respectfully submits that none of the prior art of record, applied alone or in combination, teaches or suggests the unique combination and arrangement of elements recited in claims 1, 4, and 6 of the present application. Claims 2, 3, 8, 9, and 12 depend upon claim 1 and are therefore allowable for at least the

Serial No. 09/731,004

July 25, 2003

Reply to the Office Action dated February 12, 2003

Page 6 of 6

reasons that claim 1 is allowable. Claims 5, 10, and 13 depend upon claim 4 and are therefore allowable for at least the reasons that claim 4 is allowable. Claims 7, 11 depend upon claim 6 and are therefore allowable for at least the reasons that claim 6 is allowable.

In view of the foregoing amendments and remarks, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

To the extent necessary, Applicant petitions the Commissioner for a THREE-month extension of time, extending to August 12, 2003, the period for response to the Office Action dated February 12, 2003.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

Date: July 25, 2003

  
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